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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,898	10/03/2001	Zhiyuan Gong	1781-0163P	5940

2292 7590 07/30/2003

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EXAMINER
WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
1632	13

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

File

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/913,898		Gong et al.	

EXAMINER	
Woitach, Joseph	
ART UNIT	**PAPER NUMBER**
1632	13

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.
Commissioner of Patents

See Attached.

DETAILED ACTION

This application is a 371 national stage filing of PCT/SG99/00079, filed July 16, 1999 which claims benefit to foreign application 9900811-2, filed February 18, 1999 in Singapore.

Applicant's amendment filed May 12, 2003, paper number 12, has been received and entered. Claims 1-18 have been canceled. Claims 19-59 have been entered. Claims 19-59 are pending.

Election/Restriction

Applicants' response to the restriction requirement is noted. Specifically, Applicants note that claims 1-18 have been canceled, and that newly added claims 19-59 are 'directed to in essence a"method of doing business"' (page 6, Section II). Applicants indicate that the newly added claims are not believed to "fit into any of the restriction groups identified by the Examiner with respect to the previous claims" (page 6, Section II).

The amendment filed on May 12, 2003, paper number 12, canceling all claims drawn to the inventions set forth in the restriction requirement and presenting only claims drawn to a new invention is **non-responsive** (MPEP § 821.03). As acknowledged by Applicants, the remaining claims are not readable on the elected invention.

Since the above-mentioned amendment appears to be a bona fide attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

The original restriction requirement is re-iterated below for Applicants' convenience.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

I. Claims 1, 5, 6, 14, 15, drawn to a zebrafish cytokeratin gene promoter, classified in class 536, subclass 24.1.

II. Claims 2, 5, 6, 14, 15, drawn to a zebrafish creatine kinase gene promoter, classified in class 536, subclass 24.1.

III. Claims 3, 5, 6, 14, 15, drawn to a zebrafish fast muscle isoform of myosin light chain 2 gene promoter, classified in class 536, subclass 24.1.

IV. Claims 4, 5, 6, 14, 15, drawn to a zebrafish ribosomal protein P0 gene promoter, classified in class 536, subclass 24.1.

V. Claims 7-13, 16, drawn a transgenic fish comprising a zebrafish cytokeratin gene promoter, classified in class 800, subclass 20.

VI. Claims 7-13, 16, drawn a transgenic fish comprising a zebrafish creatine kinase gene promoter, classified in class 200, subclass 20.

VII. Claims 7-13, 16, drawn a transgenic fish comprising a zebrafish fast muscle isoform of myosin light chain 2 gene promoter, classified in class 800, subclass 20.

VIII. Claims 7-13, 16, drawn a transgenic fish comprising a zebrafish ribosomal protein P0 gene promoter, classified in class 800, subclass 20.

IX. Claim 17, drawn a transgenic fish comprising a zebrafish ribosomal protein P0 gene promoter, classified in class 800, subclass 20.

X. Claim 18, drawn a transgenic fish comprising a zebrafish ribosomal protein P0 gene promoter, classified in class 800, subclass 20.

Claims 5, 6, 14, 15 are generic to groups I-IV and will be examined to the extent they encompass the elected invention. Claims 7-13, 16 are generic to groups V-VIII and will be examined to the extent they encompass the elected invention.

The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

A) The invention has no special technical feature that defined the contribution over the prior art, or

B) Unity of invention between different categories of inventions will only be found to exist if specific combinations of inventions are present. Those combinations include:

1) A product and a special process of manufacture of said product.

2) A product and a process of use of said product.

3) A product, a special process of manufacture of said product, and a process of use of said product.

4) A process and an apparatus specially designed to carry out said process.

5) A product, a special process of manufacture of said product, and an apparatus specially designed to carry out said process.

The allowed combinations do not include multiple products, multiple methods of using said products, and methods of making multiple products as claimed in the instant application, see MPEP § 1850. In the instant case, Applicant's claims encompass multiple inventions and do not have a special technical feature which link the inventions one to the other, and lack unity of invention.

Specifically, the inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different polynucleotide sequences represent unique and different promoter sequences with different inherent properties as demonstrated by a particular expression pattern in a cell.

Inventions V-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case each of the transgenic fish comprise a different promoter which results in a material different genome in the transgenic fish. Additional, the inherent activity of each of the promoters if expressed may provide a unique phenotype to each of the transgenic fish of each of the inventions.

Inventions I-IV and V-VIII, respectively, are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the promoters can be used for expression studies in vitro, as probes for detecting the presence of the respective gene, or as a target sequence for an anti-sense oligonucleotide.

Inventions IX and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the methods require a transgenic fish comprising different promoters. The genome of the transgenic fish in each case are different and unique thus the methods require different starting materials. Further, the methods require the administration and analysis of two different classes of compounds; steroid-like compounds and heavy metals.

Inventions V-VIII and IX-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the methods require a transgenic fish comprising promoters which are different from those specifically set forth in the inventions of groups V-VIII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Further, because these inventions are distinct for the reasons given above and the search required for each on of Group I-X is not required or coextensive with each other, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (703) 308-2141.

Joseph T. Woitach

Deborah Crouch

DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1800/630